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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/493,484 01/28/00 VAN LOON

A 1999.454 US

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HM22/0926

EXAMINER

PARKIN, J

ART UNIT

PAPER NUMBER

1648

DATE MAILED:

09/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/493,484

Applicant(s)

Van Loon, A.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/29/00
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Applicant: Van Loon, A.

Docket No.: 1999.454
Filing Date: 01/28/00

Restriction Requirement

35 U.S.C. § 121

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- a. Group I, claim(s) 1-4 and 13, drawn to an **avian reovirus**, classified in class 435, subclass 235.1.
- b. Group II, claim(s) 5-9 and 14, drawn to a **vaccine** comprising an **avian reovirus** and a **pharmaceutically acceptable diluent**, classified in class 424, subclass 215.1.
- c. Group III, claim(s) 10, drawn to a **method** for the **preparation** of **avian reoviruses**, classified in class 435, subclass 239.
- d. Group IV, claim(s) 11, 12, and 15¹, drawn to a **method** for the **preparation** of a **vaccine**, classified in class 435, subclass 236.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects (refer to M.P.E.P. ¶s 806.04 and 808.01). In the instant case, the reovirus of Group I can be employed in a number of different biochemical assays (i.e., infectivity, ligand-binding, affinity chromatography) while the pharmaceutical composition of Group II, which has a different composition and attendant products that comprise it, can be employed in materially different processes such as vaccination and therapeutic applications. Therefore, each invention is clearly

¹ Claim 15, which is directed toward claim 10, actually appears to be directed toward a method of preparing a vaccine (claim 11) since it involves a viral inactivation step and the addition of a carrier or diluent. Accordingly, it has been included in Group IV (claims 11 and 12). If the claim is not directed toward such a method, appropriate clarification and amendment will be required.

drawn toward a different inventive entity.

4. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have
5 different functions, or they have different effects (refer to M.P.E.P. ¶s 806.04 and 808.01). In the instant case, each of the groups identified is directed toward a different scientific objective (i.e., the preparation of virus or a vaccine) that employs materially different reagents and assay steps.
10 Accordingly, each invention is clearly drawn toward a different inventive concept.

5. Inventions I and IV, and II and III, respectively, are unrelated. Inventions are unrelated if it can be shown that they
15 are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects (refer to M.P.E.P. ¶s 806.04 and 808.01). In the instant case, neither of the methods requires the products of the corresponding groups. Therefore, each
20 invention is clearly drawn toward a different inventive entity.

6. Inventions I and III are related as product made and process of making. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can
25 be used to make other and materially different products, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. ¶ 806.05(f)). In the instant case, the reovirus of Group I can be prepared through alternative methodologies such a PCR amplification from the host of interest or through selective
30 culturing techniques.

7. Inventions II and IV are related as product made and process of making. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can be used to make other and materially different products, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. ¶ 806.05(f)). In the instant case, the vaccine of Group II can be prepared through alternative methodologies such as PCR amplification, selective culturing, or physical/chemical inactivation.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, requirement for independent searches, and recognized divergent subject matter, restriction for examination purposes as indicated is proper. **Applicant is required under 35 U.S.C. § 121 to elect a single group for prosecution on the merits.** Applicants are also reminded that the claims should be amended, if necessary, to reflect the election.

Correspondence

9. The Art Unit location of your application in the Patent and Trademark Office has changed. To facilitate the correlation of related papers and documents for this application, all future correspondence should be directed to **art unit 1648**.

10. Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Official communications should be directed toward one of the following Group 1600 fax numbers: (703) 308-4242 or (703) 305-3014. Informal communications may be submitted directly to the Examiner through the following fax number: (703) 308-4426. Applicants are encouraged to notify the Examiner prior to the submission of such documents to facilitate their expeditious processing and entry.

11. Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-

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2227. The examiner can normally be reached Monday through Thursday from 8:30 AM to 6:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, James Housel or Laurie Scheiner, can be reached at (703) 308-4027 or (703) 308-1122, respectively. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Respectfully,

Jeffrey S. Parkin, Ph.D.
Patent Examiner
Art Unit 1648

25 September, 2001